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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,910	07/30/2003	Roy Lillqvist	60091.00217	6100

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EXAMINER

ADAMS, CHARLES D

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,910

Applicant(s)

LILLQVIST ET AL.

Examiner

Charles D. Adams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. In response to communications filed on 19 April 2006, claims 1-4 and 8-11 are amended. Claims 1-12 are pending in the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites in line 6 that the step of "converting at least one of said at least one Internet domain name into a second format in which at least two successive labels of the at least one of said at least one Internet domain name are combined to form a single label" occurs "conditionally", yet no claim of the conditions is made in claim 1. This renders claim 1 indefinite, as one of ordinary skill in the art would not know what conditions such a step occurs under.

4. The following is a quotation of the 4th paragraphs of 35 U.S.C. 112, 4th:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

5. Claim 4 is rejected under 35 U.S.C. 112, 4th paragraph, because claim 4 does not further limit claims 1 or 3.

Claim 1 recites the limitation of conditionally converting at least one Internet domain name into a second format.

Claim 4 states that when the examining step of claim 3 indicates that the converting step is performed when the Internet domain name includes at least the predetermined number of labels beyond the given origin, said labels having the predetermined maximum length, and that the converting step is not performed when the examining step of claim 3 indicates that the Internet domain name does not include at least the predetermined number of labels.

Therefore, a possibility exists wherein the method of independent claim 1, in which no specific conditions are claimed, would convert at least one Internet domain name into a second format, while the conditions later claimed in claim 4 would preclude such conversion.

In claim 1, a step of conversion may occur.

In claim 4, this step of conversion may not occur under certain specified conditions.

Therefore, as claim 4 could render invalid a step occurring in claim 1, claim 4 does not further limit claims 1 or 3.

Claim Rejections - 35 USC § 102

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (US Pre-Grant Publication 2002/0083198).

As to claim 1, Kim et al. teaches:

Receiving data to be supplied to database operations, the data including at least one Internet domain name comprising a plurality of successive labels separated by dots (see paragraph [0034]. Dashes are functionally equivalent to dots. Both serve as delimiters in series of labels), said at least one Internet domain name being in a first format (see paragraph [0034]. The name address given is an Internet domain name because it is used to look up an IP address in a Domain Name Server (see paragraph [0035]). The name address given corresponds to an IP address, so it can be considered to be an "Internet domain name");

The claims contain subject matter that is optionally recited. As such, the claims bear no patentable weight. See MPEP § 2106 Section II(C):

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes

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optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

This list of examples is not intended to be exhaustive. >See also MPEP § 2111.04.<

“Conditionally converting at least one of said at least one Internet domain name into a second format in which at least two successive labels of the at least one of said at least one Internet domain name are combined to form a single label” is optionally recited and bears no patentable weight because it may not actually occur.

Kim et al. teaches supplying the data to the database operations, the supplied data including at least one Internet domain name in the second format (see paragraph [0035]).

As to claim 2, Kim et al. teaches further comprising a step of examining whether an Internet domain name fulfills a predetermined condition in the first format (see paragraph [0034]. Conversion only occurs if the number entered contains a '#' sign).

As to claim 3, Kim et al. teaches wherein the examining step includes examining whether said Internet domain name includes at least a predetermined number of labels beyond a given origin, said labels having a predetermined maximum length (see

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paragraphs [0030] and [0034]. If there is more than one distinct label, they will be separated. The labels have a predetermined max length of 15 digits).

As to claim 4, Kim et al. teaches wherein the converting step is performed for said Internet domain name when the examining step indicates that the Internet domain name includes at least the predetermined number of labels beyond the given origin, said labels having the predetermined maximum length (see paragraphs [0030] and [0034]. The step of combining is performed when there is more than one label).

The remainder of the claim receives no patentable weight. See the rejection of claim 4, under 35 U.S.C. 112th paragraph, listed above.

As to claim 9, Kim et al. teaches:

First means for receiving data to be supplied to database operations, the data including at least one Internet domain name comprising a plurality of successive labels separated by dots (see paragraph [0034]. Dashes are functionally equivalent to dots. Both serve as delimiters in series of labels), said at least one Internet domain name being in a first format (see paragraph [0034]. The name address given is an Internet domain name because it is used to look up an IP address in a Domain Name Server (see paragraph [0035]). The name address given corresponds to an IP address, so it can be considered to be an "Internet domain name");

Second means for converting at least one of said at least one Internet domain name into a second format in which at least two successive labels of the at least one of

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said at least one Internet domain name are combined to form a single label (see paragraph [0034]); and

Third means for supplying the data to database operations, the supplied data including at least one Internet domain name in the second format (see paragraph [0035]).

As to claim 10, Kim et al. teaches further comprising fourth means for examining whether an Internet domain name fulfills a predetermined condition, the second means being configured to convert the Internet domain name into the second format when the Internet domain name fulfills the predetermined condition (see paragraph [0034]. Conversion only occurs if the number entered contains a '#' sign).

As to claim 11, Kim et al. teaches:

A first interface for receiving data to be supplied to database operations, the data including at least one Internet domain name comprising a plurality of successive labels separated by dots (see paragraph [0034]. Dashes are functionally equivalent to dots. Both serve as delimiters in series of labels), said at least one Internet domain name being in a first format (see paragraph [0034]. The name address given is an Internet domain name because it is used to look up an IP address in a Domain Name Server (see paragraph [0035]). The name address given corresponds to an IP address, so it can be considered to be an "Internet domain name");

A modification module operably connected to the first interface for converting at least one of said at least one Internet domain name into a second format in which at least two successive labels of the at least one of said at least one Internet domain name form a single label (see paragraph [0035]); and

A second interface, operably connected to the modification module for supplying the data to database operations, the supplied data including at least one Internet domain name in the second format (see paragraph [0035]).

As to claim 12, Kim et al. teaches a computer program product, the product comprising computer readable code being configured to cause a computer to substantially perform the steps of claim 1 when executed by said computer (see paragraph [0023]).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (US Pre-Grant Publication 2002/0083198).

As to claim 5, Kim et al. does not teach wherein the predetermined number of labels is three.

However, it would have been obvious for one skilled in the art at the time the invention was made to have modified Kim et al. to include that limitation, because only a size (predetermined number of labels) is changing (see *In re Rose*, 220 F .2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F .2d 1048, 189 USPQ 143 (CCPA 1976), *Gardner v. TEC Systems, Inc.*, 725 F .2d 1338, 220 USPQ 777 (FED Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984) and MPEP 2144.04 IV.A – Changes in Size/Proportion).

As to claim 6, Kim et al. does not teach wherein the predetermined maximum length is one byte.

However, it would have been obvious for one skilled in the art at the time the invention was made to have modified Kim et al. to include that limitation, because only a size (predetermined maximum length) is changing (see *In re Rose*, 220 F .2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F .2d 1048, 189 USPQ 143 (CCPA 1976), *Gardner v. TEC Systems, Inc.*, 725 F .2d 1338, 220 USPQ 777 (FED Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984) and MPEP 2144.04 IV.A – Changes in Size/Proportion)).

As to claim 7, Kim et al. does not teach wherein the predetermined maximum length is one byte.

However, it would have been obvious for one skilled in the art at the time the invention was made to have modified Kim et al. to include that limitation, because only a size (predetermined maximum length) is changing (see *In re Rose*, 220 F .2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F .2d 1048, 189 USPQ 143 (CCPA 1976), *Gardner v. TEC Systems, Inc.*, 725 F .2d 1338, 220 USPQ 777 (FED Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984) and MPEP 2144.04 IV.A – Changes in Size/Proportion)).

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (US Pre-Grant Publication 2002/0083198) in view of Khello et al. (US Pre-Grant Publication 2003/0007482).

As to claim 8, Kim et al. teaches a method according to claim 1.

Kim et al. does not teach:

-receiving data including another Internet domain name in the second format;
and

-converting the another Internet domain name received in the second format
back to the first format.

Khello et al. teaches:

-receiving data including another Internet domain name in the second format
(see paragraph [0055] and Figure 8. Numbers are entered in a format of a single label);
and

-converting the another Internet domain name received in the second format back to the first format (see paragraph [0055] and Figure 8. Numbers entered in a format of a single label are converted to numbers comprised of multiple labels).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Kim et al. by the teaching of Khello et al., since Khello et al. teaches that “the present invention may be used to establish a multimedia or other communications session that includes one or more of the following example applications: voice-over-IP, web surfing, e-mail, videoconferencing, video-on-demand, audio-on-demand, intranet-work access, gaming, and gambling, either with or without a circuit switched voice communication” (see paragraph [0054]).

Response to Arguments

11. Applicant's arguments filed 19 April 2006 have been fully considered but they are not persuasive.

As to Applicant's argument that the 112, 4th paragraph rejection should be withdrawn, it should be noted that independent claim 1 recites that a step of conversion may occur. This step could be rendered impossible by the conditions later set forth in claim 4.

As to Applicant's arguments that Kim et al. does not disclose an “Internet domain name comprising a plurality of successive labels separated by dots”, it should be noted

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that the E.164 number is a name address that corresponds to an IP address (see paragraph [0035]). The name address is used by a DNS to look up an IP address (see paragraph [0035]). As such, the name address is an Internet domain name. As to the comparison of dashes and dots, the two are both as delimiters to separate one label from another. Thus, they are functionally equivalent.

As to applicant's arguments towards claims 5-7 and the cited case law (see *In re Rose*, 220 F .2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F .2d 1048, 189 USPQ 143 (CCPA 1976), *Gardner v. TEC Systems, Inc.*, 725 F .2d 1338, 220 USPQ 777 (FED Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984) and MPEP 2144.04 IV.A – Changes in Size/Proportion), Applicant's arguments have been considered but are incorrect. The predetermined number of labels indicates the size of the domain name. If one name has more labels than another, then that name can be argued to be larger. Thus, the cited cases are applicable to the current application's limitations on the number of labels.

In response to arguments that Khello et al. does not teach "receiving data to be supplied to database operations, the data including at least one Internet domain name comprising a plurality of successive labels separated by dots, said at least one Internet domain name being in a first format" as recited by claim 1, it is noted that those features of the invention are being taught by Kim et al. As the rejection was based on 35 U.S.C. 103, the references are combined to teach the entirety of the claim.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art to have combined Kim et al. and Khello et al., since Khello et al. teaches that "the present invention may be used to establish a multimedia or other communications session that includes one or more of the following example applications: voice-over-IP, web surfing, e-mail, videoconferencing, video-on-demand, audio-on-demand, intranet-work access, gaming, and gambling, either with or without a circuit switched voice communication" (see paragraph [0054]).

In response to applicant's argument that the references used and the present application do not solve the same problem, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). There is no requirement that references solve the same problem the same way as one another or as the present application.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles D. Adams whose telephone number is (571) 272-3938. The examiner can normally be reached on 8:30 AM - 5:00 PM, M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles Adams
AU 2164



SAM RIMELL
PRIMARY EXAMINER